

ITZKOVITCH -- 10/076,591
Client/Matter: 081627-0265363

REMARKS

Claims 1-20 are pending in the application. Reconsideration and allowance in view of the following remarks are respectfully requested.

Claims 1, 9 and 19 were rejected under Vasudeva (U.S. Patent No. 5,887,715) in view of Rysgaard et al. (U.S. Patent 6,193,062). The rejection is respectfully traversed.

Claim 1 recites a tool container including a case portion defining a storage space. A one-piece cover portion is movably attached to the case portion and is pivotally moveable between a closed position in which the cover portion covers an upwardly facing opening of the storage space and an open position in which access to said storage space through the upwardly facing opening is permitted. The cover portion is securable in the closed position. The one-piece cover portion has an elongated level storage space integrally formed in one piece therewith for storing a level therein, and a secondary cover portion pivotably mounted to the cover portion for movement between a closed position wherein the secondary cover portion covers the elongated level storage space to retain the level therein and an open position wherein access to the level stored in the elongated storage space is permitted. A handle is connected to the cover portion to facilitate transport of the tool container.

MPEP § 2141 states:

Patent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case. The Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), stated:

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy...

It is respectfully submitted that the Examiner has failed to apply the standard of patentability set forth in MPEP § 2141. In particular, it is respectfully submitted that the Examiner has failed to correctly determine: 1) the scope and content of the prior art; 2) the differences between the prior art and the claims; and 3) the level of ordinary skill in the art.

The Examiner, on page 2, paragraph number 3, alleges that Vasudeva discloses a cover portion (3, 46) pivotally attached to a case portion 1. The Examiner goes on to state

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that Vasudeva discloses an elongated storage space 41, 90 and a secondary cover portion 42 movably mounted with respect to the cover portion 3, 46 for covering the elongated storage space 41, 90.

Firstly, the lid 3 and the body 46 of the snap-in module 8 of Vasudeva are not properly interpretable as a one-piece cover portion. The body 46 and the lid 3 are clearly disclosed by Vasudeva as separate elements, not one-piece as claimed. Additionally, although the lid 3 may be a cover portion, the body 46 of the snap-in module is not a cover portion. The body 46 is not pivotally attached to the main box portion 1, it is snapped into the rectangular opening 6 (Figs. 1 and 2) or the storage space 15 (Figs. 3-18). As the body 46 of the snap-in module 8 is not a cover portion, the box shaped storage container 41 and recess 90 are not an elongated storage space. In addition to not being an elongated storage space of a cover portion, the box shaped storage container 41 is also not integrally formed in one piece with a one-piece cover portion. The container 41 is an entirely separate element that is designed to be snapped into the main box portion 1, not the lid 3.

Secondly, the door 42 of Vasudeva is not a secondary cover portion pivotably mounted to a one-piece cover portion because the door 42 is mounted to the body 46 of the snap-in module 8, not to the lid 3. The body 46 of the snap-in module 8 is also not pivotably mounted, not even to the main box portion 1. The body 46 of the snap-in module 8 is secured within the rectangular opening 6 or the storage space 15 by tabs 16 and a flexible plastic arm 21 engaging slits 20 and a lip 21, respectively. The snap-in module 8 of Vasudeva is simply not pivotably mounted to any structure of the case.

Because the Examiner has failed to correctly determine the scope and content of Vasudeva, the Examiner has also failed to correctly determine the differences between the prior art and claim 1, and to correctly resolve the level of ordinary skill in the art.

The Examiner, on page 2, paragraph number 3, alleges that Rysgaard et al. disclose a container 20 comprising a case portion 24 and a one-piece cover portion having an elongated storage space integrally formed in the cover portion, as shown in Fig. 1. The Examiner concludes, on the sentence bridging pages 2 and 3 of the Office Action, that it would have been obvious to one of ordinary skill in the art to modify the tool case of Vasudeva so the elongated storage space, which the Examiner alleges is the recess 90 of the container 41 of Vasudeva, is integrally formed in the cover portion "to reduce the cost of manufacture and because it has been held that forming in one piece an article which has been formerly formed in two pieces and put together involves only routine skill in the art."

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It is respectfully submitted that one of ordinary skill in the art would not have been motivated to form the recess 90 and/or the container 41 of Vasudeva integrally with the tool case. Vasudeva clearly discloses that an object of his invention is greater flexibility by providing a storage space that may be fitted with various pre-assembled snap-in storage modules to provide the user with the flexibility of storing a wide variety of items in a wide variety of ways, depending on the user's needs. See column 1, lines 26-30. Forming the recess 90 and/or the container 41 integrally with the tool case, as proposed by the Examiner, would render the tool case of Vasudeva unsuitable for its intended purpose. One of ordinary skill in the art would not have been motivated to make such a modification.

Vasudeva also discloses that another object of his invention is to provide a tool case with a storage space which is accessed from the underside of the tool case. See column 1, lines 24-26. One of ordinary skill in the art would not have been motivated to put a storage space on the lid 3 of the tool case of Vasudeva because Vasudeva put the storage space on the underside to efficiently use the available space in the case between the panel 14 and the bottom of the main box portion 1. See column 1, lines 17-20. The modification suggested by the Examiner would render the tool case of Vasudeva unsatisfactory for at least two of its stated objectives. See MPEP § 2145X.D.

It is further respectfully submitted that even assuming one of ordinary skill in the art would have been motivated by Rysgaard et al. to form the recess 90 and/or the container 41 of Vasudeva integrally, such a modification would not have resulted in the claimed invention because the recess 90 and the container 41 of Vasudeva are provided in the main box portion 1, not the lid 3. As such, the combination of Vasudeva and Rysgaard et al. fails to include all the limitations of claim 1 and fails to present a *prima facie* case of obviousness. See MPEP § 2143.

Claims 9 and 19 recite additional features of the invention and are allowable for the same reasons discussed above with respect to claim 1 and for the additional features recited therein.

Reconsideration and withdrawal of the rejection of claims 1, 9 and 19 over Vasudeva in view of Rysgaard et al. are respectfully requested.

Claims 10, 18 and 20 were rejected under 35 U.S.C. § 103(a) over Vasudeva in view of Rysgaard et al. and further in view of Mitchell (U.S. Patent 4,058,210). The rejection is respectfully traversed.

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Claim 10 recites a combination tool container and level including a case portion defining a storage space. A one-piece cover portion is movably attached to the case portion and is pivotally moveable between a closed position in which the cover portion covers an upwardly facing opening of the storage space and an open position in which access to the storage space through the upwardly facing opening is permitted. The cover portion being securable in said closed position. The one-piece cover portion has an elongated level storage space integrally formed in one piece therewith. A level is disposed in the elongated level storage space in the cover portion, and a secondary cover portion is pivotably mounted to the cover portion for movement between a closed position wherein the secondary cover portion covers the elongated level storage space to retain the level therein and an open position wherein access to the level stored in the elongated storage space is permitted. A handle is connected to the cover portion to facilitate transport of the tool container.

The Examiner, on page 3, paragraph number 4, alleges that it would have been obvious to provide a level as shown by Mitchell, to the tool case of Vasudeva as modified by Rysgaard et al.

Applicant reiterates the arguments presented above with respect to the combination of Vasudeva and Rysgaard et al. In addition, it is respectfully submitted that one of ordinary skill in the art would not have been motivated by Mitchell to provide a level to either Vasudeva, Rysgaard et al. and/or any combination thereof.

Vasudeva discloses that the snap-in modules are provided to store a wide variety of items, however Vasudeva only mention screw drivers and bits, not a level. Rysgaard et al. disclose that the rectangular depression 33 in the upper compartment 34 is designed for holding maps and charts. Rysgaard et al. are also directed to a tackle box for storing fishing tackle. One of ordinary skill in the art would not have stored a level in a tackle box.

Claims 18 and 20 recite additional features of the invention and are allowable for the reasons discussed above with respect to claim 10 and for the additional features recited therein.

Applicant appreciates the indication that claims 2-8 and 11-17 would be allowable if rewritten in independent form. However, in view of the above remarks, it is respectfully submitted that all of the claims are allowable and that the entire application is in condition for allowance.

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Should the Examiner believe that anything further is desirable to place the application in better condition for allowance, he is invited to contact the undersigned at the telephone number listed below.

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